

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE P. KONEN

Appeal 2007-1870
Application 10/688,449
Technology Center 3700

Decided: May 31, 2007

Before WILLIAM F. PATE III, LINDA E. HORNER, and DAVID B. WALKER,
Administrative Patent Judges.

HORNER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-15. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellant's claimed invention is to a hand tool having indicia or markings used to identify the particular type of tool. In particular, the hand tool has at least two handles and a marking located on a protected surface of one or more of the handles (Specification 1:[0001]). Specifically, the marking is located on an inner or protected surface of the handle so that it is not susceptible to wear and abrasion and is not obscured from view by adjacent tools (Specification 1:[0003], [0004]).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A hand tool having two handles pivotably connected to one another, the handles terminating at a free end, each handle having first and second planar surfaces joined by inner and outer surfaces, said inner surfaces being the portions of said first and second handles facing each other, said inner surfaces being convex relative to one another at least at an end portion adjacent the free end, and indicia located on the convex end portion of the inner surface of at least one of said handles and indicating the type of said tool.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Ohno	US 3,675,359	Jul. 11, 1972
Bond	US 5,421,224	Jun. 6, 1995

The Examiner rejected claim 1-15 under 35 U.S.C. § 103(a) as unpatentable over Bond in view of Ohno, or alternatively, Ohno in view of Bond. Appellant seeks our review of this rejection.

ISSUE

Appellant contends Bond provides no disclosure or suggestion of the need to protect the indicia from wear, and as such, there is no motivation in Bond to alter the location of the indicia from the butt or terminal end or from the side surfaces shown in Bond (Appeal Br. 6, 9). Appellant further contends that Bond teaches away from relocating the indicia to the inner or protected surfaces of the handles, because doing so would obscure the view of the indicia from above (Appeal Br. 7). Appellant also contends Ohno fails to cure the deficiency of Bond (Appeal Br. 6), and Ohno fails to disclose convex inner surfaces (Appeal Br. 8).

The Examiner found that Bond discloses indicia (68) and (69) disposed on a convex inner surface of the handle, i.e., mid-portion; however, the convex inner surfaces do not face each other (Answer 5). The Examiner further found that the convex surfaces near the free ends of Ohno's handles are inner or protected surfaces because these surfaces face each other and are not meant to be grasped during normal usage (Answer 7-8). The Examiner noted the fact that Appellant has recognized another advantage, i.e., protection of the indicia from wear, which would flow naturally from following the suggestion of the prior art, cannot be the basis for patentability when the differences would otherwise be obvious (Answer 5).

The issue before us is whether the combined teachings of Bond and Ohno would have led one having ordinary skill in the art at the time of the invention to the hand tool as claimed.

FINDINGS OF FACT

The relevant facts include the following :

The Specification describes the “inner” or “protected” surfaces of the handles as follows:

It will be noted that the inner surfaces are in facing relation. Also, in normal, one-handed use of the tool the palm and fingers of a user's hand will wrap around and contact the first and second planar surfaces and the outer surfaces of the handles but they will not engage the inner surfaces. For this reason the inner surfaces will be referred to herein as protected surfaces. That is, since each inner face is protected by the facing presence of the opposite handle, the inner face is not subjected to wear or abrasion from a user's hands. Furthermore, the protected surface is less likely to have an adjacent tool in a container lodged right next to it [Specification 3:[0008]].

Bond recognizes that in the art, artisans who use tools on a consistent basis can waste considerable time attempting to pick the right tool type from among a seemingly endless array of configurations for hand-held tools (Bond, col. 1, ll. 12-14 and 40-44). Thus, Bond recognizes a need in the art for providing indicia on tools to visually and tactilely indicate to the user the head type of a tool (Bond, col. 2, ll. 31-33). Bond teaches that it is an object of his invention to indicate to the user by sight or touch the configuration of the tool without having to view the

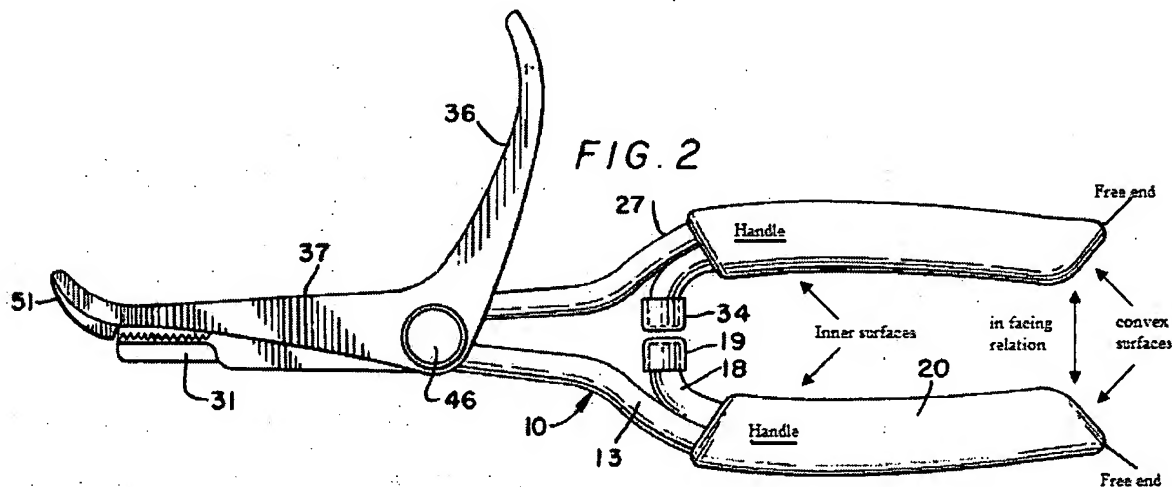
working end of the tool (Bond, col. 2, ll. 38-41). In particular, Bond discloses, with reference to Figure 8, ordinary pliers 60 with a pair of handles 62a and 62b and a working end 64 (Bond, col. 4, ll. 52-54). Bond discloses indicia 68 located on handle 62a and indicia 69 located on the opposite handle 62b that indicate the configuration of the working end or tool head (Bond, col. 4, ll. 56-61).

Alternatively, Bond teaches that indicia 70 can be formed on a blunt end 72 of either handle 62a or 62b (Bond, col. 4, ll. 63-66). Bond teaches that indicia located on the butt end of a tool “will be most useful when used in conjunction with a tool belt or tool pouch” because the butt of the tool will face upwards towards the user’s line of vision when stored in the belt or pouch (Bond, col. 5, ll. 54-61).

Bond does not disclose the inner surfaces of the pliers being convex relative to one another at least at an end portion adjacent a free end, where the indicia are located on the convex end portion of the inner surface of at least one handle.

Ohno discloses a hand tool, as shown in Figure 2 reproduced below, having handle grips 20 (Ohno, col. 3, l. 1). As noted on the annotated Figure 2 below, the handles include inner surfaces, i.e., surfaces in facing relation, and free ends. As visible in Figure 2, the inner surfaces turn outwardly toward the free ends such that they are convex relative to one another at end portions thereof adjacent the free ends of each handle. The convex surfaces, however, are still in facing relation to each other and protected by the facing presence of the opposite handle so that a user’s palm and fingers will not engage these convex surfaces during normal, one-handed use. As such, Ohno’s convex surfaces form end portions of the inner or

protected surfaces of the handles. Ohno does not disclose indicia located on the convex end portion of the inner surface of at least one of the handles.



Annotated Figure 2 of Ohno showing convex end portions

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. *See id.* at 1073, 5 USPQ2d at 1598. In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of

ordinary skill in the art. In addition to these factual determinations, the examiner must also provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (*cited with approval in KSR Int’l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *Id.* at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

The Court recently expounded on the obviousness determination in *KSR*, stating:

The question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art. Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.

KSR, 127 S. Ct. at 1742, 82 USPQ2d at 1397.

The Court further explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same

reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396.

ANALYSIS

The Examiner held that “[i]t would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of Ohno with the indicia as taught by Bond to adapt the tool with marking indicating the type and/or the size of the tool” (Answer 5). The Examiner further found the fact that the motivation for placing the indicia on the convex end portions of the tool is for line of sight, and not for the reason of reduced wear as intended by the present application, does not exclude the combined references from rendering the claimed combination obvious (Answer 8). We agree with the Examiner.

As we found *supra*, Ohno discloses convex surfaces on the end portions of the inner surfaces of the handles adjacent their free ends. Bond recognizes a need in the art for providing indicia on tools to visually indicate to the user the head type of a tool and Bond, thus, discloses applying indicia on a blunt end of either handle of a pair of pliers so that the indicia is facing upwards and is thus easily visible when the pliers are stored in a tool belt. Bond provides a clear incentive or motivation for one skilled in the art to modify Ohno to add indicia on its ends to visually indicate to the user the head type of the tool. It does not matter that the problem being solved by the resulting prior art combination is different from the

problem of wear being solved by the claimed invention. *See KSR*, 127 S.Ct. at 1742, 82 USPQ2d at 1397 (“any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed”).

In the case of Ohno’s hand tool, the tool does not have a blunt end, but rather a tapered end. Thus, the surface of Ohno’s handle most closely facing in the upward direction, and thus most easily visible to a user when the tool is in a tool belt, is the convex end portion of the inner surface of each handle. Applying the indicia, as taught in Bond, to the convex end portion of the inner surface of the handles of Ohno’s tool would have been an obvious improvement to Ohno’s tool, because it would improve Ohno’s tool in the same way as it improved the pliers in Bond, and application of the technique would not have been beyond the skill of one of ordinary skill in the art. *See KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

As such, the combination of Bond and Ohno would have rendered obvious the features of independent claim 1, 6, and 11. In particular, Bond and Ohno would have led one having ordinary skill in the art to a hand tool having, *inter alia*, inner surfaces convex relative to one another at least at an end portion adjacent the free end and indicia located on the convex end portion of the inner surface of at least one of the handles (claims 1 and 11) and a hand tool having handle portions convex relative to one another at least at an end portion adjacent the free end, having protected surfaces facing one another on the convex end portion, and an indicia located on a protected surface of at least one of the handles (claim 6). Appellant has not presented any arguments as to the separate patentability of

Appeal 2007-1870
Application 10/688,449

dependent claims 2-5, 7-10, and 12-15. As such, these claims fall with their respective independent claims 1, 6, and 11. 37 C.F.R. § 41.37(c)(1)(vii) (2006).

CONCLUSIONS OF LAW

We conclude that Appellant has not shown that the Examiner erred in finding claim 1-15 unpatentable under 35 U.S.C. § 103(a) over the combination of Bond and Ohno.

DECISION

The decision of the Examiner to reject claims 1-15 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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